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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,117	11/27/2001	David Sonnenberg	5810.02	1589

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INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER, CO 80202-5647

EXAMINER	
NERBUN, PETER P	
ART UNIT	**PAPER NUMBER**
3765	5

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n N .	Applicant(s)	
	09/996,117	Sonnenberg et al	
	Examiner	Art Unit	
	Peter P Nerbun	3765	

-- The MAILING DATE of this c mmunication appears on the cover sheet with th correspondence address --

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☒ Responsive to communication(s) filed on *27 November 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-104* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,19-22,32-34,43-49,58-62,71-79,83-86,90-93 and 101-104* is/are rejected.

7)☒ Claim(s) *5-18,23-31,35-42,50-57,63-70,80-82,87-89,94-100* is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 November 2001* is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of the CERTIFIED copies of the priority documents have been:

1.☐ received.

2.☐ received in Application No. (Series Code / Serial Number) _____ .

3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15)☒ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18)☐ Interview Summary (PTO-413) Paper No(s). _____ .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other: .

An Information Disclosur Stat m nt has been filed however it is not present in the application file. Copies of the IDS and the post office receipt for the IDS are requested. These copies should be filed with the response to the instant Office action.

The drawings are considered to be informal because they fail to comply with 37 CFR 1.84(b)(1) which requires black and white drawings using India ink or its equivalent. Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. If the subject matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. In the instant application Figs. 2A, 2B, 4A, 4B, 6, 7, 8, 9, 9A, 9B, and 9C may be illustrated by a drawing. Accordingly a proposed drawing correction to replace the photographs of Figs. 2A, 2B, 4A, 4B, 6, 7, 8, 9, 9A, 9B, and 9C with a drawings is required if a response is made to the instant Office action. Applicant may not request that the objection to the drawings be held in abeyance. See 37 CFR 1.85(a).

The drawings are further objected to for containing spelling errors. In Fig. 3 and in Fig. 5, "Colour" must be changed to --Color--.

The disclosure is objected to for containing grammatical errors. Note, for xample, page 3, line 5 of the specification, after "in", --a-- should be inserted. The specification should be reviewed to correct this and other such errors.

Claims 12, 50-57, 64-70, 78, 94-104 are objected to for containing errors in grammar and syntax. In claim 94, line 1, after "in", --a-- should be inserted. In claim 12, line 2, after "in", --a—should b inserted. In claim 50, line In claim 64, line 2, after "in", --a-- should be inserted. In claim 78, line 2, applicant recites "third" without having

previously recit d "s cond". This error in syntax should be corr cted. Claims 94-104 will be deemed allowable upon making this correction.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 19, 32, 43, 46-49, 58, 62, 71, 74, 83, 86, 90, 93, and 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisatake. The patent to Hisatake discloses a method of reproducibly making photographs of different fabrics comprising the steps of placing a fabric 50, Fig. 6 on a background surface 49, Fig. 7 and then photographing the fabric. It would have been obvious that the method includes the step of folding the fabric 50, Fig. 6 since a pocket flap such as the one along the upper edge of pocket 50, Fig. 6 is commonly known to be folded over a pocket to protect the contents of the pocket. With respect to the ranges of angular values recited in claims 48, 49, and 62, it would have been obvious to select the angular ranges recited therein in carrying out the method disclosed by Hisatake since applicant has presented no vidence of the criticality of these claimed ranges. In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall b entitled to a patent unless –

(b) th invention was pat nted or described in a print d publication in this or a for ign country or in public us or on sale in this country, mor than on y ar prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 19, 32, 43, 46, 58, 71, 74, 83, 86, 90, 93, and 101 are rejected under 35 U.S.C. 102(b) as being anticipated by Becker et al. The patent to Becker et al discloses a method of reproducibly making photographs of different fabrics comprising the steps of folding each fabric in the same way (see fabric 10, Figs. 1, 2 folded about fold lines 20, Figs. 1-3), placing the folded fabric on a background surface (the solid black area in Fig. 6), and then photographing each draped and folded fabric in a first same way (see col. 3, lines 13-19).

Claims 5-18, 23-31, 35-42, 50-57, 63-70, 80-82, and 87-89 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 19-22, 32-34, 43-46, 59-61, 71-77, 83-86, 90-92, and 101-104 are rejected under 35 U.S.C. 102( )/103 as being anticipat d by Quigl y et al. The pat nt to Quigley et al discloses a photograph of a fabric (s e col. 6, lines 6-9). Claims 19-22, 32-34, 43-46, 59-

61, 71-77, 83-86, 90-92, and 101-104 are product-by-process claims. Ev n though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Also note MPEP 2113 which states that "The lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).". In the instant application the photograph of Quigley et al as described in col. 6, lines 6-9 of the reference's disclosure appears to be identical to the product claimed in the product-by-process claims.

Claims 78 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al in view of Hisatake et al. To convert the photographs of Becker et al as shown in Figs. 6 and 7 to computer-generated photo-r alistic images as suggested by Hisatake et al (at col. 4, lines 13-17 and Fig. 6 where th photograph is displayed a

computer generated photo-r alistic image on lectronic display 14) would hav be n obvious since the image could be electonically manipulated to gain a better understanding of the fabric's texture.

Claims 95-100 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter P Nerbun whose telephone number is 703-308-0955. The examiner can normally be reached on M-F (1st Week) M-Th (2d Week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Peter Nerbun
September 4, 2003

Peter Nerbun
Primary Examiner